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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/664,247	09/18/2000	Wilhelm Elsner	2384/001440	4085

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EXAMINER	
MCCORMICK, SUSAN B	
ART UNIT	PAPER NUMBER
1661	

DATE MAILED: 03/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

9/664,247

Applicant(s)

Elsner

Examiner

McGormick

Group Art Unit

1661

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 2/24/03.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ ☐ Interview Summary, PTO-413
- ☒ Notice of References Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

Office Action Summary

In view of the Reply Brief filed on February 24, 2003, PROSECUTION IS HEREBY REOPENED. A rebuttal to the Reply Brief is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by the European Union application for plant breeder's right number PBR 970950, filed September 3, 1997 and published December 15, 1997, as stated in the Examiner's Answer (paper 13, pp. 2-3).

Rebuttal to Reply Brief

Appellant's Reply Brief introduces new evidence and raises two new points of argument. In the interest of fully developing the issue at hand and placing the question before the Board of Appeals as expeditiously as possible, the examiner has chosen to reopen prosecution. The examiner adheres to all of the positions set forth in the Examiner's

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Answer. This Office action is limited to discussion of the new arguments presented in the Reply Brief.

Appellant argues that, pursuant to Article 87(1) of Council Regulations (EC) No. 2100/94, only the names of the breeder and his representative, the taxon statement (i.e. the species of plant) and provisional denomination were available for public inspection (Reply Brief, p. 2). It is unclear how Appellant arrived at this conclusion.

Article 87 states, in part:

Article 87

Establishment of the Registers

1. The Office shall keep a Register of Applications for Community Plant Variety Rights which shall contain the following particulars:

(a) applications for a Community plant variety right *together with* a statement of the taxon and the provisional designation of the variety, the date of application and the name and address of the applicant, of the breeder and of any procedural representative concerned; [emphasis added]

Article 88 states, in part:

Article 88

Public inspection

1. The Registers mentioned in Article 87 shall be open to public inspection.

Thus it appears that the items listed by Appellant are kept in the Register "together with" the application.

In any event, both examiner and Appellant are in agreement that adding additional botanical description to the publicly available application information would not "enable" the printed words therein. The published application is an enabling disclosure by virtue of the public availability of the plant itself, which is required to make (asexually reproduce) the plant. No matter how much descriptive information was available to the public, the fact remains that the plant was in the public domain and the public was notified of this fact. Anyone interested in new geranium varieties, such as a nurseryman seeking new varieties to grow for retail sale, could have used the available information to contact the plant breeder

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and arrange to purchase the plant. With the plant in hand, it would not require any further exercise of inventive skill to asexually reproduce it by cuttings or other means known to one skilled in the art.

Appellant argues that the *LeGrice* court had evidence of commercial sale of the claimed plants (Reply Brief, pp. 3-5). This argument is not persuasive. Contrary to Appellant's assertion, the facts in the instant case are not identical to those presented in *LeGrice*. The *LeGrice* decision states, "The particular question of law to be here decided is presented on stipulated facts, which, insofar as they relate to the issue, are here quoted from the record..." 133 USPQ at 367. The list of facts that follows does not include the stipulation that the plants sought to be patented were on sale anywhere.

Appellant argues that the *LeGrice* Board of Appeals disposed of the issue of public sale enabling a printed publication. This argument is not persuasive because the Board ruled that the printed publications alone (i.e. without evidence of public availability of the claimed plants) warranted a rejection under 35 U.S.C. 102(b). The question of whether public availability of the plants would "enable" the publications was not considered by the Board or the CCPA.

Moreover, applicant *LeGrice* never stated that the claimed plants were on sale, nor did he provide copies of the catalogue publications (Reply Brief, attachment, p. 22, "The catalogues have not been made available"). How could the Board or the CCPA have known the contents of publications that were never part of the record? It appears that the Board's conclusion that the plant was on sale and in public use in England had no basis in fact. Naturally, the applicant did not comment on this conclusion because the Board went on to state that it was irrelevant, i.e. not the basis for the rejection (Reply Brief, attachment,

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p. 22, last paragraph). The fact that LeGrice was listed as "distributor" does not in itself indicate that the claimed plants had already been distributed to the public, nor would mere display at an exhibition put the public in possession of the claimed plants. In *Ex parte Thomson*, the Board of Appeals concluded that the *LeGrice* case did not have in evidence facts supporting commercial availability of the claimed plants (24 USPQ2d 1618, 1621).

Conclusion

No claim is allowed. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Oral Arguments

The supervisory patent examiner requests the opportunity to present arguments at the oral hearing.



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